REMARKS

By this amendment, claims 1-11 and 13 have been canceled without prejudice or disclaimer of the subject matter thereof; claims 12 and 14-15 have been amended; and claims 16-17 have been added. Claims 12 and 14-17 are currently pending.

Claims 1-2 and 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,477,332 to Ohsawa.[1] Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohsawa in view of U.S. Patent Application Publication 2001/0050875 by Kahn et al. ("Kahn"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohsawa in view of U.S. Patent No. 6,226,449 to Inoue et al. ("Inoue"). Claims 6-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,470,413 to Ogawa in view of U.S. Patent No. 6,396,744 to Wong et al. ("Wong").

Applicant respectfully submits that because claims 1-11 and 13 have been canceled, the rejections of these claims under § 102(e) and § 103(a) are rendered moot.

A. Claim Rejections - 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 12 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Ogawa in view of Wong. No *prima facie*

[1] The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

case of obviousness has been established with respect to claims 12 and 14-15 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed., 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed., 2001).

Amended claim 12 recites, among other things: "a memory including . . . a second storing region for storing said image data separately from camera control data specific to the digital still camera and recorded during a manufacturing process." Ogawa and Wong, taken alone or in combination, fail to teach or suggest at least this element of claim 12.

According to the Examiner, Ogawa discloses an electronic still camera comprising a memory (flash ROM 15) that includes at least a first storing region and a second storing region, one of which is employed to store firmware. See Office Action, § 7, at 10-11, citing Ogawa at col. 7, lines 29-33. However, Ogawa also discloses that

the firmware stored in flash ROM 15 is developed and/or upgraded firmware. See Ogawa, col. 7, lines 29-33, disclosing that "part of the flash ROM 15 . . . is convenient for the development of firmware and for the upgrading of the firmware version for a camera." Ogawa, col. 7, lines 29-33. Developed and/or upgraded firmware is distinct from and therefore does not constitute "camera control data *specific* to the digital still camera and *recorded during a manufacturing process*," as claimed. Wong, relied on for its disclosure of a multi-bank construction of flash memory, fails to cure this deficiency.

Therefore, Ogawa fails to teach or suggest "a memory including . . . a second storing region for storing said image data separately from camera control data specific to the digital still camera and recorded during a manufacturing process," as recited in claim 12. Wong fails to cure this deficiency. Accordingly, no *prima facie* case of obviousness has been established with respect to claim 12 and the 35 U.S.C. § 103(a) rejection of claim 12 should be withdrawn.

Claims 14-15 and new claims 16-17 depend from and add additional features to independent claim 12. Accordingly, these claims are allowable for at least the reasons set forth above and Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 31, 2005

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